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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,067	04/23/2004	Stephen D. Deadwyler	SD50702.UPA	7678

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EXAMINER

HENDERSON, MARK T

ART UNIT PAPER NUMBER

3722

DATE MAILED: 12/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/830,067

Applicant(s)

DEADWYLER, STEPHEN D.

Examiner

Mark T. Henderson

Art Unit

3722

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☒ Other: Attachment I.

DETAILED OFFICE ACTION

Faxing of Responses to Office Actions

In order to reduce pendency and avoid potential delays, TC 3700 is encouraging FAXing or responses to Office Actions directly into the Group at (571) 273-8300. This practice may be used for filing papers, which require a fee by applicants who authorize charges to a PTO deposit account. Please identify the examiner and art unit at the top of your cover sheet. Papers submitted via FAX into TC 3700 will be promptly forwarded to the examiner.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation "the system" in line 2. There is insufficient antecedent basis for this limitation in the claim. Should this state "the method"?

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1-4, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over “Cat Hymns” Internet Site in view of Lee (5,791,488).

The “Cat Hymns” site discloses in Fig. 1 and 2, a method of preparing books for sale comprising: the provision of a book (A) with a unique cover illustrations (B); a book bag (C) having a pocket, wherein the bag corresponding to the book and having identical external illustrations (D) corresponding with the cover illustrations associated with the book.

However, the “Cat Hymns” site does not disclose enclosing and selling the book within the bag; wherein a copy of the front cover illustration of the book is placed on one panel of the bag and a copy of the back cover illustration is placed on the opposite panel of the bag; and providing a series of books and book bags.

Lee discloses in Fig. 3, a display bag having a content illustration associated with the item enclosed in a pocket for selling of the item.

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the “Cat Hymn”’s site to enclose and sell an item in a pocket

of a bag that is displayed with a item illustration on the panel of the bag as taught by Lee for the purpose of storing and protecting the desired item.

In regards to **Claim 2**, it would have been an obvious matter of design choice to place any desired unique illustration on the panel of the bag, since applicant has not disclosed that the back cover illustration placed on an opposite panel of the bag solves any stated problem, and it appears that the invention would perform (selling) equally well with one unique cover illustration on one panel of the bag.

In regards to **Claims 1**, it would have been obvious to one having ordinary skill in the art at the time the invention was made to construct as many books and bags as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to construct as many bags as desired, since applicant has not disclosed the criticality of having more than one bag, and invention would function equally as well with any number.

2. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lee (5,791,488) in view of Wolf (4,757,580).

Lee discloses in Fig. 1 and 2, a consumer item and bag product comprising: a bag having external illustrations (32) on side panels (30) and enclosing a consumer products or items. The method for the sale and distribution of the item is inherently taught by Lee.

However, Lee does not disclose: a consumer item to be a book with a unique cover illustration.

Wolf discloses in Fig. 1, a book having a unique cover illustration (3).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Lee's method of preparation to include a consumer item in the form a book having a cover illustration as taught by Wolf for the purpose of depicting the book's contents.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct as many books and bags as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to construct as many bags as desired, since applicant has not disclosed the criticality of having more than one bag, and invention would function equally as well with any number.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable indicia on the book and bag's front cover, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability.

Therefore, it would have been obvious to place any type of indicia on the book and front cover of

the bag, since applicant has not disclosed the criticality of having particular indicia, and the invention would operate equally as well with any type of indicia.

In regards to applicant's limitation that the external illustrations of the bag corresponds to the illustrations of the book, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art. Therefore the display illustrations of Lee are capable of being the same illustrations on the cover of an inserted book and wherein the book and bag display can be exchanged among individuals.

3. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smallwood (4,874,340).

Smallwood discloses in Fig. 1-3, a book (40) and bag (10) product comprising: a bag (as seen in Fig. 3) having external illustrations (28) on side panels (12 and 14) and enclosing a book (40) having unique cover illustrations (as seen in Fig. 2). The method for the sale and distribution of the book and bag product is inherently taught by Smallwood.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to construct as many books and bags as desired, since it has been held that mere duplication of the essential working parts of a device involves only routine skill in the art. Therefore, it would have been obvious to construct as many bags as desired, since applicant has

not disclosed the criticality of having more than one , and invention would function equally as well with any number.

It also would have been obvious to one having ordinary skill in the art at the time the invention was made to include any desirable indicia on the book and bag's front cover, since it would only depend on the intended use of the assembly and the desired information to be displayed. Further, it has been held that when the claimed printed matter is not functionally related to the substrate, it will not distinguish the invention from the prior art in terms of patentability. The fact that the content of the printed matter placed on the substrate may render the device more convenient by providing an end user with a specific type of information document or form does not alter the functional relationship. Mere support by the substrate for the printed matter is not the kind of functional relationship necessary for patentability. Therefore, it would have been obvious to place any type of indicia on the book and front cover of the bag, since applicant has not disclosed the criticality of having particular indicia, and the invention would operate equally as well with any type of indicia.

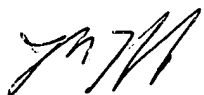
In regards to applicant's limitation that the external illustrations of the bag corresponds to the illustrations of the book, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. In a claim drawn to a process of making, the intended use must result in a manipulative difference as compared to the prior art.

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Therefore the display illustrations of Lee are capable of being the same illustrations on the cover of an inserted book and wherein the book and bag display can be exchanged among individuals.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark T. Henderson whose telephone number is (571) 272-4477, and informal fax number is (571) 273-4477. The examiner can be reached on Monday-Friday from 9:00AM to 3:45PM. If attempts to reach the examiner by telephone are unsuccessful, the Examiner Supervisor, Boyer Ashley, can be reached at (571) 272-4502. The formal fax number for TC 3700 is (571) 273-8300.



MTH

December 5, 2005



BOYER D. ASHLEY
PRIMARY EXAMINER